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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,745	11/20/2001	Mark S. Garrison	680.0039USU	9671

7590 08/26/2003

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 08/26/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/989,745

Applicant(s)

GARRISON ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION*****Election/Restrictions***

Applicant's election of group I, claims 1-30 in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for fluorocarbon, does not reasonably provide enablement for all volatile components. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The enablement test requires that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. See MPEP § 2164.01, reciting In re Wands, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). To determine whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue", following factors are considered: the breadth of the claims; the nature of the

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invention; the state of the prior art; the level of one of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the content of the disclosure. See In re Wands, at 737

In this case, "volatile" compound as recited in the claim 1 can be any compound having volatility, such as ethanol, butane, or cyclodimethylsiloxanes. The scope of the claim is so broad as to recites that a composition having any volatile compounds, if used in an "effective" amount to give self-renewal property, can have "textured surface appearance". A wide variety of volatile compounds are known in the state of the prior art, and there is no direction or working examples provided by the inventor to enable the volatile compounds other than fluorocarbon volatile compounds. Undue experimentation would be required to determine the efficacy of the presently claimed invention.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to the invention commensurate in scope with these claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The term “textured surface appearance” in claim 1 renders the claim vague and indefinite. Examiner views that any composition having granules, bubbles, or foam would also meet the limitation, and it is not clear what the metes and bounds of the scope of the claim are. Claim 11 further recites that the “textured appearance is self-foaming or self-whipping”. While it is viewed that foam or lather would meet this limitation, it is not clear what the metes and bounds of the scope of the limitation are. The claims are also vague and confusing because, the terms “self-foaming” and “self-whipped” pertain to a certain physical properties of a composition, but applicants in this case use these terms to describe a visual aspect of the composition, “textured surface appearance”. The term “self-foaming” indicates a property of a composition that generates lather and foam by action of a volatile-self-foaming agent. See Barnett et al. (US 5326556), col. 1, lines 11-25. While applicants redefine the terms “self-foaming” and “self-whipping” to mean that “the surface [of the composition] becomes re-texturized during a pre-determined period of time, such definition still pertains to the physical properties of the composition. See specification, p. 1, lines 16-19. Is there a difference between the appearances of plain foam/lather and a composition having the textured appearance of self-foaming composition? The claims are vague, indefinite, and confusing.

The term “pre-determined period of time” in claim 1 renders the claim vague and indefinite. Applicants’ disclosure does not indicate the meaning of the term or how to ascertain or measure that time period.

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The term "removably sealable" in claim 7 renders the claim vague and indefinite. Examiner views that that a cap may be "removable and sealable", but the description as recited in the claim is vague and confusing.

The term "original, textured surface appearance" renders claim 26 vague and indefinite. It is not clear what is considered as "original textured surface appearance", and the metes and bounds of the scope of the claims are unclear.

The remaining claims are rejected as depending on indefinite base claims.

### ***Claim Objections***

Claims 8 and 9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 8 and 9 recite that the composition of claim 1 is placed in a jar, and a container having adjustable inner volume. The subject matter of claim 1 is a composition. Examiner views that claims 8 and 9 fail to further limit the composition of claim 1.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-9, 11-13, 23-25, and 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett et al. (US 5326556) in view of Patterson et al. (US 5248495).

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The claimed invention is a composition having a textured surface, volatile compound in a certain amount, and a viscosity ranging from 5,000 cps to 100,000 cps. As discussed above, a foam or lather having the recited ingredients and viscosities would meet the limitation. Examiner views that the recitation in the claim that the composition is in a container does not render any structural limitation to the composition because where the composition is contained does not affect the constituents or structure of the foam composition.

Barnet teaches self-foaming shaving composition comprising 0.5-10 % by weight of a volatile self-foaming agent and additionally 0.0005-0.5 of fluorosurfactant. See col. 1, line 54 – col. 2, line 48. Examiner views that it is obvious that the Barnet invention encompasses compositions having textured surfaced since the reference teaches using the volatile self-foaming agent, which gives the textured appearance and self-renewing properties, because the reference teaches the amount which meets applicants claim limitation in claim 1, line 3. See instant claims 23-25; specification p. 10, lines 23-29. The reference teaches that self-foaming compositions are typically oil-in-water emulsions. See col. 1, lines 13 – 51; instant claims 2-3. The reference teaches using skin care ingredients such as humectants and skin conditioners, which indicates that the invention is also directed to treatment of skin. See col. 1, lines 54-65; instant claim 30.

Examiner notes that the prior art teaches and suggests the composition which meets all the structural limitations of the instant claims. That the composition is “self-renewable” and “renews the textured appearance in the

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container during a pre-determined period of time after each use of the composition", is a physical property of the composition which should be obviously present in the composition having the components as the applicants' invention. See instant claims 1 and 7. Examiner views that whether the composition is placed in a jar having adjustable inner volume does not affect the structural limitation of the composition itself nor does it change the properties of the composition. See instant claims 8 and 9.

Barnet fails to specifically teach the viscosity of the foaming composition.

Patterson teaches post-foaming shaving gel. The reference teaches that the gel composition has viscosities between 15000 cps and 60000 cps. See col. 4, lines 33-68. See instant claims 1-6. The reference teaches that gallants are used to improve the consistency of the gel and its thermal stability, and provides increased lubricity to the foam, and the viscosity is critical to keep the post-foaming agent into the gel. See col. 4, lines 34- 45. Volatile liquid post-foaming agents are described in col. 3, line 55 – col. 4, line 11.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have adjusted the viscosities of the Barnet shaving gel to the viscosities between 15,000 cps and 60,000 cps as motivated by Patterson, because of an expectation of successfully producing a foaming shaving gel which provide increased lubricity to the foam.

2. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zastrow et al. (US 5667772) in view of Bratescu et al. (US 6528070 B1).



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Zastrow teaches a cream composition comprising aqueous fluorocarbon emulsion. See example 1. The reference teaches that 0.05-80% by weight of the fluorocarbon emulsion may be used in the invention, wherein the fluorocarbon may be in the range from 20-100% weight/volume. See col. 3, lines 18-22; Exemplary embodiments. Perfluoroalkane having 6-9 carbons are disclosed. See col. 1, lines 61-67. The reference teaches that the fluorocarbons – perfluorinated or highly fluorinated- have oxygen solubility, partial vapour pressure, and further teaches to mix various fluorocarbons to improve the rate of penetration of the skin. See col. 2, line 53 – col. 3, line 4; instant claims 12-22. The reference teaches that the invention may be in the form of liquid, semi-liquid, or solid, and discloses the specific examples of applications such as cream, face mask, gel, etc. See instant claim 10.

While the reference does not specifically teach that the invention has “textured surface appearance”, or “original, textured surface appearance”, given the indefinite scope of the limitation, examiner takes the position that the composition having same volatile perfluoro or partially fluorinated composition meeting the claim limitation, in the same amount in the same oil-water emulsion cream form as the instant claims require, the prior art composition obviously possesses the physical characteristics recited in the instant claims. See instant claims 1 and 7. Examiner views that whether the composition is placed in a jar having adjustable inner volume does not affect the structural limitation of the composition itself nor does it change the properties of the composition. See instant claims 8 and 9.

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The reference fails to provide specific viscosities of the compositions.

Bratescu teaches cosmetic emulsions. The reference teaches that the viscosity of the composition can vary from thin as 100 cps, to cream like consistency of 80,000 cps. See col. 13, lines 33-35.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have adjusted the viscosity of the Zastrow compositions to the viscosities as motivated by Bratescu, because of an expectation of successfully producing the cosmetic compositions with desired viscosities.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

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Gina C. Yu  
Patent Examiner



SREENI PADMANABHAN  
PRIMARY EXAMINER

8/25/05